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	& WILLIAMS LLP	DIVINE, LUCAS			
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Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
	10/003,411	GUPTON ET AL.			
Office Action Summary	Examiner	Art Unit			
	Lucas Divine	2624			
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).					
Status					
1)⊠ Responsive to communication(s) filed on <u>06 December 2001</u> .					
	action is non-final.				
• • • • • • • • • • • • • • • • • • • •	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.				
Disposition of Claims		•			
4) ☐ Claim(s) 1-38 is/are pending in the application. 4a) Of the above claim(s) is/are withdrawn from consideration.  5) ☐ Claim(s) is/are allowed.  6) ☐ Claim(s) 1-38 is/are rejected.  7) ☐ Claim(s) is/are objected to.  8) ☐ Claim(s) are subject to restriction and/or election requirement.					
Application Papers					
9) ☐ The specification is objected to by the Examine 10) ☑ The drawing(s) filed on <u>09 January 2002</u> is/are: Applicant may not request that any objection to the or Replacement drawing sheet(s) including the correction of the order of the order of the correction of the order of the order order of the correction of the order orde	a) accepted or b) objected drawing(s) be held in abeyance. See on is required if the drawing(s) is obj	37 CFR 1.85(a). ected to. See 37 CFR 1.121(d).			
Priority under 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  a) All b) Some * c) None of:  1. Certified copies of the priority documents have been received.  2. Certified copies of the priority documents have been received in Application No  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  * See the attached detailed Office action for a list of the certified copies not received.					
Attachment(s)					
Notice of References Cited (PTO-892)     Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) Interview Summary ( Paper No(s)/Mail Da	te			
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	5) Notice of Informal Pa	atent Application (PTO-152)			

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### **DETAILED ACTION**

## **Drawings**

- 1. The drawings were received on 1/9/2002. These drawings are accepted, but are objected to as specified below.
- 2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 51, 53, 60. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
- 3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: 54, 34, 36, 38. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either

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"Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

## Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 4. Claims 1, 15, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Daniels, Jr. et al. (US 6343327).

Regarding claim 1, Daniels teaches a system for electronically delivering documents

(Fig. 1, of which includes the more specific elements of subsequent figures), said system

comprising:

a document system (100, Fig. 1), said document system producing document information for printing documents (shown as providing documents and addresses and control info in Fig. 1 to print stream processor 102 - Fig. 2 as well shows sending documents from 200 and information for printing the documents [instructions, col. 4 lines 49-52] from 204, both part of 100; col. 4 lines 36-45);

a print management system (102, Fig. 1), wherein said print management system accepts document data and document print requests from said document system (shown as receiving documents and addresses and control info in Fig. 1 from sender's mainframe 100), and further wherein said print management system determines whether a requested document is designated for electronic delivery or non-electronic delivery (Fig. 1 shows the determination of whether to forward the document to the electronic or non-electronic delivery streams as noted below; col. 3 lines 43-45; col. 4 lines 46-64; col. 1 line 66-col. 2 line 2; col. 5 lines 18-19);

a recipient database (202, Fig. 2), wherein said recipient database stores recipient information (addressing information for customers [col. 3 line 29] - inherently must know where to route the physical mail, e-mail, fax, pager, etc. and the customer database has the information on the customers);

a print system (physical delivery printstream including 104-106 to physical mail of Figs. 1 and 2), wherein said print system is configured to receive and print documents designated for non-electronic delivery (receives the documents, prints them, and sends them out via physical mail, Fig. 1; col. 3 lines 45-48 and 56-67); and

an email system (electronic delivery printstream including 110 – 113, Fig. 1), said email system configured to accept and process document data for creating and delivering documents electronically (col. 4 lines 1-34, col. 3 lines 49-55).

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Regarding claim 15, the structural elements of apparatus claim 1 perform all of the method steps of method claim 15. Therefore, method claim 15 is rejected for the same reasons set forth in the rejection of apparatus claim 1.

Regarding claim 28, the structural elements of apparatus claims 4, 5, 6, and 1 perform all of the method steps of method claim 28. Therefore method claim 28 is rejected for the reasons set forth in the rejection to apparatus claims 4, 5, 6, and 1.

The structural elements of apparatus claims 4 – 6 are provided here showing the limitations as all taught by Daniels. Daniels teaches a parsing engine (web router 112, Fig. 1), wherein said parsing engine receives document data from said print management system for documents selected for electronic delivery (as part of the electronic delivery printstream, Fig. 1 shows the electronic documents going to 112/113 blocks), and further wherein said parsing engine processes said document data for storage (outputs the electronic document as web content [processes into web content – further it can processes the data by encrypting it as shown in Fig. 1] and outputs to web server for storage; col. 4 lines 10-25). Daniels teaches a server (116, Fig. 1), wherein said server provides on-line access to the document data and electronic documents stored by said parsing engine (col. 2 lines 15-16, col. 4 lines 10-25; col. 6 lines 10-12). Daniels teaches the email system composes and transmits electronic notices regarding the status and availability of stored documents and document data (col. 2 lines 19-20; col. 4 lines 18-25; col. 6 lines 21-28).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 5. Claims 2 7, 10, 16 20, 22, 29 31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniels as applied to claim 1 above, and further in view of Quine (US 6782415).

Regarding claim 2, which depends from claim 1, Daniels teaches a consent database (202, Fig. 2, Daniels teaches the database 202 is both the customer [recipient] database and it stores the delivery preference [consent information] in that database as well), said consent database storing each potential document recipient's selected document delivery designation to receive documents electronically or non-electronically (col. 4 lines 46-49; col. 3 lines 29-30).

Daniels does not specifically teach that the consent database information is a separate database from the recipient database.

However, Quine teaches nearly an identical system by the same assignee including a consent database, recipient database, document system, print management system, and email system (see Figs. 1-4 and associated text). Further, the database system 130 of Quine holds recipient information [recipient] and holds preference information [consent] as discussed in col. 4 lines 40-67. The database system is taught to be implemented in any way the user would like, as one database, multiple, etc.. (col. 7 lines 18-30).

Therefore it would have been obvious to one of ordinary skill in the art that the single database shown in Daniels could have been implemented as multiple databases. The motivations for doing so would have been to have two smaller databases for faster access and if only one type of information is needed (e.g. only consent information) at a given time, only one database need be accessed and the accessing can be faster because there is less data to search through. Other

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Regarding claim 3, which depends from claim 2, Daniels teaches the print management system determines whether to process a document for electronic on non-electronic delivery based upon a document delivery designation stored in said consent database (col. 3 lines 43-45; col. 4 lines 46-64; col. 1 line 66-col. 2 line 2; col. 5 lines 18-19).

motivations for having multiple databases instead of one large one are well known in the art.

Regarding claim 4, which depends from claim 3. Daniels teaches a parsing engine (web router 112, Fig. 1), wherein said parsing engine receives document data from said print management system for documents selected for electronic delivery (as part of the electronic delivery printstream, Fig. 1 shows the electronic documents going to 112/113 blocks), and further wherein said parsing engine processes said document data for storage (outputs the electronic document as web content [processes into web content – further it can processes the data by encrypting it as shown in Fig. 1] and outputs to web server for storage; col. 4 lines 10-25).

Regarding claim 5, which depends from claim 4, Daniels teaches a server (116, Fig. 1), wherein said server provides on-line access to the document data and electronic documents stored by said parsing engine (col. 2 lines 15-16, col. 4 lines 10-25; col. 6 lines 10-12).

Regarding claim 6, which depends from claim 5, Daniels teaches the email system composes and transmits electronic notices regarding the status and availability of stored documents and document data (col. 2 lines 19-20; col. 4 lines 18-25; col. 6 lines 21-28).

Regarding claim 7, which depends from claim 5, Daniels teaches that the email system composes electronic documents comprised of document data (col. 6 lines 35-47, wherein the electronic delivery printstream formats [composes] the documents electronically in a variety of formats for delivery) and transmits said electronic documents to electronic document recipients (delivery shown in Fig. 1 and cited in parent claims).

Regarding claim 10, which depends from claim 5, Daniels does not specifically teach the document delivery designations for multiple recipients are changed together based upon common identifying criteria.

However, Quine teaches the document delivery designations for multiple recipients are changed together based upon common identifying criteria (distributions lists are commonly identifying criteria for multiple recipients; col. 2 lines 60; col. 5 lines 1-7).

It would have been obvious to use the distributions lists in the similar system of Daniels as they are used in Quine. Distributions lists are a common and well known feature of electronic

deliveries and are used to enable the quick setup and mailing to a group (department, group, or any other list of participants) instead of selecting each one individually and also to change features for a whole group instead of just for the one individual. For example, meeting announcements can be transmitted to a whole group instead of each individual separately (col. 5 lines 24-25 of Quine).

Regarding claims 16, 17, 29, and 30, which depend from claims 15 and 28, the structural elements of apparatus claim 2 perform all of the method steps of method claims 16, 17, 29, and 30. Therefore, method claims 16, 17, 29, and 30 are rejected for the same reasons set forth in the rejection of apparatus claim 2.

Regarding claims 18 and 31, which depend from claims 17 and 30, the structural elements of apparatus claim 3 perform all of the method steps of method claims 18 and 31.

Therefore, method claims 18 and 31 are rejected for the same reasons set forth in the rejection of apparatus claim 3.

Regarding claim 19, which depends from claim 18, the structural elements of apparatus claim 4 perform all of the method steps of method claim 19. Therefore, method claim 19 is rejected for the same reasons set forth in the rejection of apparatus claim 4.

Regarding claim 20, which depends from claim 19, the structural elements of apparatus claim 7 perform all of the method steps of method claim 20. Therefore, method claim 20 is rejected for the same reasons set forth in the rejection of apparatus claim 7.

Regarding claims 22 and 33, which depend from claims 19 and 29, the structural elements of apparatus claim 10 perform all of the method steps of method claims 22 and 33.

Therefore, method claims 22 and 33 are rejected for the same reasons set forth in the rejection of apparatus claim 10.

6. Claims 11 – 13, 23 – 26, and 34 - 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quine and Daniels as applied to claims 6, 22, and 33 above, and further in view of Reilly (US 6427164).

Regarding claim 11, which depends from claim 6, Daniels email system is further comprised of a failed email management system (regeneration processor 118, Fig. 1), wherein said failed email management system is configured and arranged to receive a notice of a failed email delivery including a failed email address (col. 4 lines 26-34), and to change a document delivery designation for an intended recipient of a failed email to receive documents non-electronically (col. 2 lines 20-23; col. 4 lines 26-34; col. 5 lines 36-45; col. 7 lines 5-30 and 45-57).

Note: Quine also teaches similar features in col. 5 line 50 – col. 6 line 21 and col. 8 lines 42-46.

The item that Daniels and Quine do not specifically teach is forwarding all future requests to non-electronically.

However, Reilly However, Reilly teaches forwarding (via forwarding list server 300, Fig. 2) a message to a new address if the old address fails (col. 2 lines 29-32; col. 4 lines 10-15 and throughout) including automatically forwarding to the new address in the future in the future (see abstract and col. 4 line 2).

It would have been obvious to one of ordinary skill in the art to automatically send to correct forwarded addresses on future deliveries, which corresponds to setting the delivery option in Daniels. The motivation for doing so would have been to save time and resources and not deliver to the failed email address and just transmit directly to the known, workable address.

Regarding claim 12, which depends from claim 11, while Quine and Daniels teach the forwarding of the document to the recipient in a non-electronic way when the email (or electronic) method fails — which implicitly includes being able to look up the same user in the database for their corresponding physical address (thus reading on retrieves a name data field and an address data field from the recipient database), the combination fails to teach that the actual forwarding includes extracting identifying email data fields from said notice of a failed email delivery and retrieves a name data field and an address data field from the recipient database based on the extracted identifying email data fields.

However, Reilly teaches forwarding (via forwarding list server 300, Fig. 2) a message to a new address if the old address fails (col. 2 lines 29-32; col. 4 lines 10-15 and throughout) extracting identifying email data fields from said notice of a failed email delivery (col. 2 lines 29-32; col. 2 line 67-col. 3 line 3; col. 3 lines 15-35; col. 7 lines 10-13; col. 8 lines 56-59 – email field examples given such as user2 [col. 6 line 37] or DestinationUsername [col. 6 line 65]) and retrieves a name data field and an address data field from the recipient database based on the extracted identifying email data fields (Reilly uses the mail recipient's name [col. 2 lines 29-32] for looking up the new address in the server; col. 7 lines 10-13; 'internal table of names' col. 7 line 29).

It would have been obvious to one of ordinary skill in the art that a name must be used to look up the new address to forward the message to, and since Quine and Daniels receive a failure notification in electronic form (same as Reilly), it would have been obvious to draw the username for looking up the user's alternate addresses via the electronic communication as taught in Reilly. The motivation for doing so would have been a fast and easy way to look up the new address. No other types of record keeping would need to be kept to associate a certain message with a user because the user's name could be drawn right from the electronic form of the message.

Regarding claim 13, which depends from claim 12, Reilly further teaches an Internet server (forwarding list server 300, Fig. 2 [on internet, col. 6 line 5]), wherein said Internet server provides access for the intended recipient to correct said failed email addresses (col. 8 lines 40-41).

Regarding claims 23 and 34, which depend from claims 22 and 33, the structural elements of apparatus claim 11 perform all of the method steps of method claims 23 and 34. Therefore, method claims 23 and 34 are rejected for the same reasons set forth in the rejection of apparatus claim 11.

Regarding claims 24 and 35, which depend from claims 23 and 34, the combination of Quine and Daniels teach sending notices to recipients with delivery information (see rejection of

claim 6) and also performing delivery actions based on failed emails – re-routing to nonelectronic delivery methods.

It would have been obvious that if an electronic notice could not have been emailed, that it would be re-routed to non-electronic methods for delivery just as other documents are re-routed. The motivation for doing so would have been to allow notices to reach users that wouldn't have since the email address failed.

But the combination does not teach that the notice can be a notice of a failed email delivery.

Reilly teaches sending a non-delivery report of failed email addresses to users (col. 7 line 32 and throughout –referred to as NDR).

It would have been obvious that if a user receives a notice that their print job is going to be non-electronically delivered (in the case above where the email address fails), that it would include such information. The motivation for doing so would have been that the user would updated their email address in the system (as discussed in other claims regarding Reilly) and future communications would be correct.

Regarding claims 25 and 36, which depend from claims 24 and 35, the structural elements of apparatus claim 12 perform all of the method steps of method claims 25 and 36.

Therefore, method claims 25 and 36 are rejected for the same reasons set forth in the rejection of apparatus claim 12.

Regarding claims 26 and 37, which depend from claims 25 and 36, the structural elements of apparatus claim 13 perform all of the method steps of method claims 26 and 37.

Therefore, method claims 26 and 37 are rejected for the same reasons set forth in the rejection of apparatus claim 13.

7. Claims 14, 27, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quine, Daniels, and Reilly as applied to claims 13, 26, and 37 above, and further in view of Bruce et al. (US 6741724) and Seestrom (US 6647385).

Regarding claim 14, which depends from claim 13, the combination of Quine, Daniels, and Reilly teach updating a user address via the Internet as discussed in claim 13. They do not teach a postcard form template accessible via the Internet, wherein the intended recipient may print the postcard form template, provide information requested on the postcard form template and mail the postcard form template back for processing.

However, Bruce teaches it is well known in the art to change an address of a user by a form template accessible via the Internet (forms via internet, col. 1 lines 61-63), wherein the intended recipient may print the postcard form template, provide information requested on the postcard form template and mail the postcard form template back for processing (col. 1 line 61 - col. 2 line 5).

It would have been obvious to one of ordinary skill in the art to change an associated address via forms in order to allow the user to fill out a manual form instead of doing it online. The motivation for this (as stated in Bruce, col. 2) is that public acceptance of online updating of addresses has been slow, and a vast majority of people will continue to opt for existing ways of updating addresses (filling out the pages).

While Bruce teaches postcards in the mail system, Bruce does not specifically teach the form to be printed on a postcard.

Seestrom teaches printing change of address forms on postcards (Figs. 3, 5, and 7 and their descriptions, including col. 6 line 40).

It would have been obvious to print a change of address form on a postcard. The motivation would have been that postcards are cheaper to send through the mail than standard sheets of paper in envelopes.

Regarding claims 27 and 38, which depend from claims 26 and 37, the structural elements of apparatus claim 14 perform all of the method steps of method claims 27 and 38.

Therefore, method claims 27 and 38 are rejected for the same reasons set forth in the rejection of apparatus claim 14.

8. Claims 8, 9, 21, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Quine and Daniels as applied to claims 6, 7, 20, and 30 above, and further in view of Smith et al. (US 6385655).

Regarding claim 8, which depends from claim 6, while the combination of Quine and Daniels teaches sending notices to a recipient, the combination does not specifically teach email system combines multiple electronic notices for delivery to a single recipient at one time.

However, Smith teaches sending notices to a user once documents to deliver have been stored (col. 2 lines 64-67, col. 5 line 48 – col. 6 line 4) and multiple electronic documents for delivery to a single recipient at one time (Fig. 4, 112, wherein multiple documents can be sent in

one transmission to recipients in 110). Thus, when the documents were available for delivery, the system would not send a separate notice for each document (as in Quine and Daniels), but would send a combined notice for all the documents (e.g. sending the URLs for the documents in one transmission instead of each separately).

Since it would have been obvious for Quine and Daniels to send multiple documents at once for delivery instead of just sending one at a time in order to save transmission time and effort, which also saves bandwidth not having the extra information and headers, it would have also been obvious to include the notices for those documents into one transmission for similar reasons.

Regarding claim 32, which depends from claim 30, the structural elements of apparatus claim 8 perform all of the method steps of method claim 32. Therefore, method claim 32 is rejected for the same reasons set forth in the rejection of apparatus claim 8.

Regarding claim 9, which depends from claim 7, while the combination of Quine and Daniels teaches sending documents to a recipient, the combination does not specifically teach including multiple electronic documents for delivery to a single recipient at one time.

However, Smith teaches including multiple electronic documents for delivery to a single recipient at one time (Fig. 4, 112, wherein multiple documents can be sent in one transmission to recipients in 110, col. 5 line 23).

It would have been obvious to send multiple documents at once for delivery instead of just sending one at a time in order to save transmission time and effort, which also saves bandwidth not having the extra information and headers.

Regarding claim 21, which depends from claim 20, the structural elements of apparatus claim 9 perform all of the method steps of method claim 21. Therefore, method claim 21 is rejected for the same reasons set forth in the rejection of apparatus claim 9.

#### Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US-6278988, Lau et al., 8-21-2001: teaches multiple job entry points for document production control and reporting.

US-6072862, Srinivasan, 6-6-2000: teaches adaptive method and system for message delivery.

US-5826034, Albal, 10-20-1998: teaches system and method for transmission of communication signals through different media.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lucas Divine whose telephone number is 571-272-7432. The examiner can normally be reached on Monday - Friday, 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KING Y. POON PRIMARY EXAMINER Lucas Divine Examiner Art Unit 2624

ljd